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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/827,501 | 04/19/2004 | D. Scott Harper | 020028-P1-03-DCL | 3472 |

7590 12/13/2004
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EXAMINER

SHIPPEN, MICHAEL L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1621

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/827,501

Applicant(s)

HARPER ET AL.

Examiner

MICHAEL L. SHIPPEN

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 13-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/19/04; 9/27/04
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

The restriction requirement under 35 USC 121 and applicants' traversal thereof have been carefully considered. Applicants' assertion that the searches of the compounds would embrace the search of the all uses of the compounds simply is not the case. While the searches may overlap, they are not coextensive and are divergent. The fact that a very general term, phenol, can be used to characterize the claims does not show that the respective inventions are essentially the same. Applicants' argument that the inventions must be independent and distinct is without merit. Restriction is proper when inventions are distinct even if they are not independent, see MPEP 802.01. The requirement is considered proper, repeated and made final.

Claims 10 and 13-69 stand withdrawn as not reading upon the elected invention or species.

Claim Rejections - 35 USC § 102¹

Claims 1-3, 5, 8, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 3,763,287. Note the compounds 3-(3-*tert*-octyl-5-isopropyl-4-hydroxyphenyl) propanol 4-(3,5-di-*sec*-octyl-4-hydroxyphenyl) butanol listed in the bottom portion of column 3.

¹ The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 7, 9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 4,333,868. Note the compound 3-(3,5-diisopropyl-4-hydroxyphenyl) 2,2-dimethylpropanol produced in from the second reactant listed in the Table of Example 1b.

Claim Rejections - 35 USC § 103²

Claims 1-9 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 3,763,287 or USP 4,333,868. The references are applied as above. Besides the examples, the references generically teach the claimed compounds, note the compounds within the purview of formula (C) of USP 3,763,287 and formula (XVIII) USP 4,333,868. The references do not specifically exemplify the instant compound. However, the generic teaching indicates to one of ordinary skill in the art that species falling within the generic disclosure, including the instantly claimed compounds, would possess the prior art use. It is well within the skill of the artisan to select among the alternatives of the reference to afford compounds possessing the prior art use, *In re Lemin*, 141 USPQ 814. The references also disclose homologues and isomers of the instant compounds, note the above mentioned compounds and the reactants used in

² The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1621

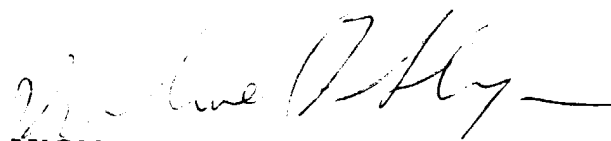
the examples of USP 3,763,287 and the products of Examples 1a to 1d of USP 4,333,868. Homologues are a class of compounds differing only by methylene linkages and possessing similar structures. Compounds of a homologous series are recognized as possessing a community of properties in common. Compounds which are positional isomers (compounds having the same radicals in physically different positions on the same nucleus) are of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 195 USPQ 426 (CCPA 1977). One would expect the various isomers having the alkyl groups at different positions to possess similar properties. Accordingly, it would have been obvious to one of ordinary skill in the art that the interchange of these isomeric or homologous substituents in the prior art compounds would afford closely related structures and compounds possessing similar properties.

Conclusion

The remaining references are cited as of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(571) 272-0647**. The Examiner's normal tour of duty is 7:30 AM to 4:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(571) 272-1600**. The official group FAX machine number is **703-872-9306**.

MShippen
December 8, 2004


MICHAEL L. SHIPPEN
PRIMARY EXAMINER
ART UNIT 1621